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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.             | CONFIRMATION NO.            |
|--|-------------|----------------------|---------------------------------|-----------------------------|
| 10/540,877   | 06/27/2005  | Hiroyuki Kanza       | 0020-5389PUS1                   | 1761                        |
| 2292 7590 05/18/2007<br>BIRCH STEWART KOLASCH & BIRCH<br>PO BOX 747<br>FALLS CHURCH, VA 22040-0747 |             |                      | EXAMINER<br>KARIKARI, KWASI     |                             |
|  |             |                      | ART UNIT<br>2617                | PAPER NUMBER                |
|  |             |                      | NOTIFICATION DATE<br>05/18/2007 | DELIVERY MODE<br>ELECTRONIC |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

## Office Action Summary

Application No.

10/540,877

Applicant(s)

KANZA, HIROYUKI

Examiner

Kwasi Karikari

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-8 and 10 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 9 canceled is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1,3-8 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Information Disclosure Statement**

1. The information disclosure statement (IDS) submitted on 06/27/2005 is in compliance with the provision of 37 CFR 1.97, has been considered by the Examiner, and made of record in the application file.

### ***Response to Arguments***

2. Applicant's arguments filed 03/13/2007 have been fully considered but they are not persuasive.

*In the remarks*, the Applicant argues (in claim 1) that "there is nothing in column 4, lines 13-50 of Welling, Jr., et al. that describes how the trigger database 52 is formed. More specifically, there is no description that the trigger database is formed by storing situation information that has been (previously) acquired via the situation acquiring means nor that the trigger data base further associatively stores operation procedures performed with respect to each situation information that is stored. Furthermore, there is no description in Welling, Jr. et al. that of the list of numbers stored in the database are stored in a hierarchical structure. A hierarchical structure requires some sort of tree structure which clearly is not disclosed in Welling, Jr. et al. Finally, there is no description in Welling, Jr. et al. that when a current situation information differs from the stored situation information, then an operation procedure to be executed is adapted to the current situation when, as a result of searching by the searching means, a broader concept of a situation information on the current situation

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agrees with that of a stored situation information", see Remarks; Page 11; however the Examiner noticed that the claimed features upon which the Applicant relies (see above) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, the Applicant argues (in claim 7) that Lange et al. fails to disclose or suggest that "the memory 130 is formed by storing situation information that has been (previously) acquired via the situation acquiring means or that the memory 130 further associatively stores operation procedures performed with respect to each situation information that is stored. Furthermore, there is no description in Lange et al. that when a current situation information differs from the stored situation information, then an operation procedure to be executed is adapted to the current situation when, as a result of searching by the searching means, a broader concept of a situation information on the current situation agrees with that of a stored situation information. Finally, there is no description in Welling, Jr. et al. that of the list of numbers stored in the database are stored in a hierarchical structure, as noted above" (see Remarks; Page 11, paragraph 3- page 12, paragraph 2). Again, the Examiner noticed that the claimed features upon which the Applicant relies (see above) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

3. Claims 2 and 9 have been canceled.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-8 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, the Applicant uses claimed limitations: "when the situation comparing means indicates that the current situation information does not agree with any of the stored situation information, adapting an operation procedure to be executed by the operation procedure executing means to a current situation when" and in claims 7 and 8, the Applicant uses the claimed limitations "when the situation comparing means indicates that the current situation information differs from the stored situation information". These limitations are not clearly presented in the Specification, thus, hampering one of ordinary skill in the art to clearly interpret the Applicant's claimed language.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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**Claims 1, 3-6 rejected under 35 U.S.C. 102(b) as being anticipated by Welling, Jr. et. al., (U.S 6, 181, 927), (hereinafter Welling).**

Regarding **claim 1**, Welling discloses an information processor (= integration of BTS, BSC, MSC and SCP, see Fig. 1) comprising:

a situation acquiring means for acquiring situation information about a situation in which an operation has been performed (= information attribute includes time of call, location of call; and subscriber ID or call made by subscriber, see col. 4, lines 13-50);

a situation and operation storage means for storing the situation information acquired by the situation acquiring means and operation information about the operation performed then in an associated manner (= trigger database stores numbers and associated called number, see col. 4, lines 13-50);

a situation comparing means for comparing a current situation information with situation information s stored in the situation and operation storage means (= called number/ID is compared with number in database, see col. 4, lines 13-50);

a situation hierarchy storage means for storing at least the situation information acquired by the situation acquiring means in a hierarchical structure (= list of numbers are stored in the database, see col. 4, lines 13-50);

a broader concept searching means for searching for a broader concept common to two situation information s compared by the situation comparing means on a basis of the situation information of the hierarchical structure stored in the situation hierarchy storage means (called number is compared with special stored numbers,

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see col. 4, lines 13-50);

an operation procedure executing means for when the situation comparing means indicates that the current situation information agrees with one of the stored situation information, executing an operation procedure according to an operation information stored in the situation and operation storage means (= matching and trigger functionality, see col. 4, lines 13-50); and

an operation adapting means for when the situation comparing means indicates that the current situation information does not agree with any of the stored situation information, adapting an operation procedure to be executed by the operation procedure executing means to a current situation when, as a result of the search by the broader concept searching means, a broader concept of a situation information on the current situation agrees with that of a situation information stored in the situation and operation storage means (= execution of sponsored message if called number/ID is matched with number/ID in the database, see col. 3, line 56- col. 4, line 58; col. 5, lines 12-42 and col. 6, lines 53-67).

Regarding **claim 3**, as recited in claim 1, Welling discloses that the information processor comprising:

a communication means for communicating with apparatuses that have their respective unique addresses (= communication between the network terminal and caller 32, see col. 3, lines 24-64 and Figs. 1, 2a & 2b) and

wherein the situation acquiring means acquires a unique address of an apparatus targeted for communications as a constituent element of the situation information via the communication means (see col. 3, lines 6-64 and col. 2, lines 31-60).

Regarding **claim 4**, as recited in claim 3, Welling discloses the information processor, wherein when the unique address of the apparatus targeted for communications has been allocated by a server, the situation acquiring means acquires an IP address of the server via the communication means (see col. 3, lines 6-64 and col. 2, lines 31-60).

Regarding **claim 5**, as recited in claim 1, Welling discloses the information processor, comprising: a situation and operation inputting means for specifying, by a user, situation information and operation information to be stored in the situation and operation storage means (= IP 44 collects response from caller 32 and forward it to SCP, see col. 3, lines 6-13).

Regarding **claim 6**, Welling discloses a portable terminal comprising the information processor (= communication caller 32 in the system, see col. 3, lines 6-64) as claimed in claim 1.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:



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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 7,8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lange et al. (U.S 6,704,564) (hereinafter Lange) in view of Welling, Jr. et. al., (U.S 6,181,927), (hereinafter Welling).**

Regarding **claims 7, 8 and 10**, Lange discloses an information processing system/method comprising a server (= service center 170) and a portable terminal (= communication device 110) to communicate with the server, wherein

the portable terminal (communication device 110) comprises:

a situation acquiring means for acquiring situation information about a situation in which an operation has been performed (= configuration signal that defines trigger conditions such as speed, temperature and location via sensor/data input, see col. 4, lines 9-24 and col. 6, lines 6-26);

a situation and operation storage means for storing the situation information acquired by the situation acquiring means and operation information about the operation performed then in an associated manner (= trigger signals are stored in memory 130 as history speed, see col. 4, line 43- col. 5, line 5 and col. 6, lines 7-33) and

a situation comparing means for comparing a current situation information with situation information s stored in the situation and operation storage means (Processor 290 parses and evaluates dynamic expression 261-63 for "true" result,

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see col. 6, lines 6-33);

an operation procedure executing means for when the situation comparing means indicates that the current situation information agrees with one of the stored situation information, executing an operation procedure according to an operation information stored in the situation and operation storage means (see col. 6, lines 6-33 and col. 5, lines 28-63); and

an operation adapting means for“ when the situation comparing means indicates that the current situation information differs from the stored situation information” adapting an operation procedure to be executed by the operation procedure executing means to a current situation when, as a result of the search by the broader concept searching means, a broader concept of a situation information on the current situation agrees with that of a situation information stored in the situation and operation storages means (message is sent of service center 170 if expression yield “true”, see col. 5, line 28- col. 6, line 33 and col. 7, lines 9-28); but fails specifically to disclose that the server comprises:

a situation hierarchy storage means for storing the situation information acquired by the situation acquiring means in a hierarchical structure; and a broader concept searching means for searching for a broader concept common to two situation information

compared by the situation comparing means on a basis of the situation information of the hierarchical structure stored in the situation hierarchy storage means.

However, Welling teaches the server (integration of BTS, BSC, MSC and SCP, see Fig. 1) that comprises:

a situation hierarchy storage means for storing the situation information acquired by the situation acquiring means in a hierarchical structure (= list of numbers are stored in the database, see col. 4, lines 13-50); and

a broader concept searching means for searching for a broader concept common to two situation information s compared by the situation comparing means on a basis of the situation information of the hierarchical structure stored in the situation hierarchy storage means (called number is compared with special stored numbers, see col. 4, lines 13-50).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Welling into the system of Lange for the benefit of achieving a system the includes the capability of transmitting messages to a subscriber station based on the location of the subscriber and other attributes of characteristics of the subscriber station (see Welling, col. 1, lines 25-63).

### ***Conclusion***

**Examiner's Note:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully

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consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

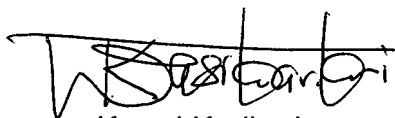
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kwasi Karikari whose telephone number is 571-272-8566. The examiner can normally be reached on M-F (8 am - 4pm). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8566.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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Patent Examiner.  
05/01/2007



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